

MAY 26 2004

OFFICIAL

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Weferling et al.

Docket: 1999DE121

Serial No.: 09/578,420

Group Art Unit: 1714

Filed: 5/25/2000

Examiner: Anthony, J.D.

For: Process For Preparing (Metal) Alkylphosphonites II

**SUPPLEMENTAL RESPONSE WITH TERMINAL DISCLAIMER**

Mail Stop:

Amendment

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

In response to a telephone conference with Examiner Anthony on May 25, 2004, please find enclosed a terminal disclaimer.

**CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8a) and 1.10**

I hereby certify that this correspondence is, on the date shown below, is being transmitted by facsimile to Centralized Facsimile Number, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, Fax No. 703-872-9306 (6 pages)

Vicki L. Sgro: 

Date: May 26, 2004

Attorney's Docket: 1999DE121  
Serial No.: 09/578,420  
Group: 1714

### REMARKS

On May 25, 2004, the undersigned had a telephone conference with Examiner Anthony. Examiner Anthony stated that a terminal disclaimer against US 6,278,012, which was required by the Office Action mailed November 14, 2003, was not received by the Office.


An examination of this Applicants' file indicates that the terminal disclaimer was facsimile transmitted on March 12, 2004 along with a Fee Transmittal Sheet, both of which were faxed in conjunction with an Amendment in response to the Office Action of November 14, 2003. Attached hereto are the Auto-Reply Facsimile Transmission for the terminal disclaimer and the Fee Transmittal Sheet.

Also attached hereto is the terminal disclaimer against US 6,278,012 along with a new Fee Transmittal Sheet.

Applicants courteously request entry of the Terminal Disclaimer.

In view of the forgoing amendments and remarks, the present Application is believed to be in condition for allowance, and reconsideration of it is requested. If the Examiner disagrees, he is requested to contact the attorney for Applicants at the telephone number provided below.

Respectfully submitted,

  
Anthony A. Bisulca  
Attorney for Applicant  
Registration No. 40,913

### **(CUSTOMER NUMBER 25,255)**

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**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING  
 REJECTION OVER A PRIOR PATENT**

Docket Number (Optional)

1999DE121

In re Application of: Norbert WEFERLING, et al., et al.

Application No.: 09/578,420

Filed: May 25, 2000

For: Process for preparing (Metal) Alkylphosphonites II

The owner\*, Clariant GmbH, of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 6,278,012. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of the prior patent, as presently shortened by any terminal disclaimer. In the event that it later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record.

Anthony A. Bisulca 3/12/2004  
 Signature Date

Anthony A. Bisulca

Typed or printed name

(704) 331-7151

Telephone Number

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) included.

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\*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).

Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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